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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,212	04/03/2001	Timothy E. Benson	00032.US1	2707

28880 7590 09/20/2005

WARNER-LAMBERT COMPANY
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ANN ARBOR, MI 48105

EXAMINER

NASHED, NASHAAT T

ART UNIT	PAPER NUMBER
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1656

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/825,212

Applicant(s)

BENSON, TIMOTHY E.

Examiner

Nashaat T. Nashed, Ph. D.

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 August 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

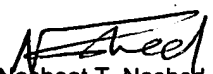
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: None.
Claim(s) objected to: None.
Claim(s) rejected: 47-62.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


Nashaat T. Nashed, Ph. D.
Primary Examiner
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In response to the objection to the specification for improper use of trademark names, applicant has amended the specification by capitalizing the trademark names. Applicants, however, is not completely responsive to the objection because they have not provided the generic terminology for the trade names. Specifically, conditions 4, 16, 29, 33, and 38 of HAMPTON CRYSTAL SCREEN I, and 6, 14, 18, 29, 34, and 36 of WIZARD SCREEN I are not defined by their generic chemical composition.

Applicant was not responsive to the objection for the use of Trademark names. The generic equivalent of the various stated conditions are not in the specification as required. Section 608.01 (v) of the MPEP states:

"The relationship between a trademark and the product it identifies is sometimes indefinite, uncertain, and arbitrary. The formula or characteristics of the product may change from time to time and yet it may continue to be sold under the same trademark. In patent specifications, every element or ingredient of the product should be set forth in positive, exact, intelligible language, so that there will be no uncertainty as to what is meant. Arbitrary trademarks which are liable to mean different things at the pleasure of manufacturers do not constitute such language. *Ex Parte Kattwinkle*, 12 USPQ 11 (Bd. App. 1931). However, if the product to which the trademark refers is set forth in such language that its identity is clear, the examiners are authorized to permit the use of the trademark if it is distinguished from common descriptive nouns by capitalization. If the trademark has a fixed and definite meaning, it constitutes sufficient identification unless some physical or chemical characteristic of the article or material is involved in the invention. In that event, as also in those cases where the trademark has no fixed and definite meaning, identification by scientific or other explanatory language is necessary. In *re Gebauer-Fuelnegg*, 121 F.2d 505, 50 USPQ 125 (CCPA 1941). The matter of sufficiency of disclosure must be decided on an individual case-by-case basis. In *re Metcalfe*, 410 F.2d 1378, 161 USPQ 789 (CCPA 1969). Where the identification of a trademark is introduced by amendment, it must be restricted to the characteristics of the product known at the time the application was filed to avoid any question of new matter. If proper identification of the product sold under a trademark, or a product referred to only by a name used in trade, is omitted from the specification and such identification is deemed necessary under the principles set forth above, the examiner should hold the disclosure insufficient and reject on the ground of insufficient disclosure any claims based on the identification of the product merely by trademark or by the name used in trade. If the product cannot be otherwise defined, an amendment defining the process of its manufacture may be permitted. Such amendments must be supported by satisfactory showings establishing that the specific nature or process of manufacture of the

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product as set forth in the amendment was known at the time of filing of the application.

Although the use of trademarks having definite meanings is permissible in patent applications, the proprietary nature of the marks should be respected. Trademarks should be identified by capitalizing each letter of the mark (in the case of word or letter marks) or otherwise indicating the description of the mark (in the case of marks in the form of a symbol or device or other nontextual form). Every effort should be made to prevent their use in any manner which might adversely affect their validity as trademarks."

Thus, whether the compositions of various conditions are known or not, applicant must identify the conditions with generic terms.

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because Figures 6a-6d are incomprehensible and do not show what is intended to be shown. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Applicant is not responsive to the above objection to the drawing in a second response. Applicant argues that the examiner may review the Figure in PCT publication WO 01/77309. WO 01/77309 is not under examination, and therefore its content is irrelevant to the examination of this application. The examiner appreciates the Figure from the published PCT application, which reproduce perfectly upon scanning the document.

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 because the specification contains reference to specific amino acid residues not identified by a sequence identification number and the *S. aureus* is not identified by a sequence identification number at each mentioning of the protein. Applicant is required to perfect their compliance with the sequence rules.

Again, applicant made a serious attempt to perfect their compliance with the sequence rule, but his effort fail short. The amendment to the specification filed August 25, 2005 is not in compliance with 37 CFR 1.121 (b), which require replacing the entire paragraph being amended.

Claims 59, 60, and 62 are objected to because of the following informalities: The claim use roman numbers "I" for the Table and the sequence identifier. Applicant should use Arabic number for the sequence identifier, and should be consistent with the

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specification and other claims in numbering the Table 1, which is numbered in Arabic number 1. Appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 56-58 and 60-62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite the limitation "wherein the three-dimensional configuration of the amino acid listed in Table". Such a limitation lacks sufficient antecedent basis in the claim from which the claims depend.

Applicant did not responsive to this rejection.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 55-62 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention (new matter rejections) for the reasons set forth in the prior Office actions.

Applicant argues that the claims are supported by the application as filed and point out to claim 55.

Applicant's arguments filed 8/25/05 have been fully considered, but they are found unpersuasive. Claims 55-62 are not part of the original disclosure. They were filed by an amendment on March 16, 2005. Applicant appears to be confusing a property of a polypeptide and the polypeptide itself. The amino acid residues defining the FDA binding pocket in three dimensions are not the same as linear polypeptide. Thus, Tables 2-4 do not describe the claimed invention. Also, the examiner has reviewed case number 5 of the Trilateral Project WM4. He would like the applicant to review the background of the case, in particular, item 3, which states:

"The description teaches that the possible polypeptides that begin with any amino acid from position 214-218 and end with any amino acid from position 394 to 401 of SEQ ID NO: 1 are protein domain that are able to

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fold into active binding pocket of protein P. This ability is confirmed by X-ray diffraction data."

The applicant has failed to point out such teaching in the specification, and the examiner could not find it. Thus, the claims remained rejected.

Claims 47-54 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for the reasons set forth in the prior Office action mailed October 19, 2004 and May 25, 2005.

Applicant reiterated his previous arguments and the teaching of the specification.

Applicant's arguments filed 8/25/05 have been fully considered, but they are found unpersuasive. Applicant is directed to the discussion above regarding the use of Trademark names. Until applicant amend the specification to introduce the generic equivalent of the conditions, the claims will remain rejected. Again, applicant cites the Trilateral Project that a crystal of protein P defined by its unit cell dimension should be in compliance with the requirement. The examiner agrees with the trilateral report provide that the claims are limited to said crystal and the specification describes how to make.

Claims 47-54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement for the reasons set forth in the prior Office action mailed October 19, 2004 and May 25, 2005.

In response to the above rejection, applicant continues to argue that the claims are fully enabled and cites the various teaching in the specification.

Applicants' arguments filed 8/25/05 have been fully considered but they are not deemed to be persuasive. Applicants should review the prior Office action. As indicated in the previous Office actions, the claims are broader in scope than the enablement provided by the specification. Even the crystal of claim 50 is not enabled because of the lack of teaching on how to make. Applicant should be reminded with the fact that growing protein crystals is highly unpredictable, and therefore, applicant should limit his claims to the exact crystal that he reported in the specification.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nashaat T. Nashed, Ph. D. whose telephone number is 571-272-0934. The examiner can normally be reached on MTTF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen M. Kerr can be reached on 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Nashaat T. Nashed, Ph. D.
Primary Examiner
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